

### Remarks

Claims 1 and 20 are amended herein. The amendments to the claims are believed to place them in condition for allowance, or at the very least, place them in better form for appeal.

Claims 1, 3, 5-10 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kasila et al. (U.S. Patent No. 5,972,595) in view of Brown et al. (High Throughput Screening, 1997).

Applicants again traverse this rejection and maintain that the Patent Office has not made out a valid case of *prima facie* obviousness.

Part of the reasoning for the rejection concerns the wording in Claim 1, "can be stimulated". Applicants believe that in context of Claim 1, no amendment is necessary; however, in order to expedite prosecution, Applicants have amended the cited phrase in Claim 1 to read "is stimulated". This amendment obviates the reasoning of paragraphs 9-11 of the Office Action.

Regarding paragraph 12 of the Office Action, Applicants reiterate their position that the methods of Kasila and Brown would need to be fundamentally changed in order to arrive at Applicants' claimed method. As pointed out in Applicants' previous response, assuming *arguendo*, that the combination of Kasila and Brown is valid, the combination still does not teach or suggest Applicants' claimed method. That is, one skilled in the art having both Kasila and Brown before him, still would not arrive at Applicants' invention.

Regarding paragraph 13 of the Office Action, it is acknowledged that at page 325, first paragraph, Brown describes an assay that shows that increased scintillation correlates with the progression of the reaction. However, the teachings of Brown et al. are of little relevance regarding the patentability of Applicants' invention. In the assay described on page 325, first paragraph, of Brown et al. a reactant, i.e., the biotinylated oligonucleotide, "is attached to a streptavidin coated FlashPlate."

In marked contrast, Applicants' method requires that "the absorption of the molecular species to the scintillation material is due to a chemical or biochemical transformation of one of said molecular species into another of said molecular species." Thus, Brown et al.'s method is fundamentally different from Applicants' claimed method and there is not a hint of guidance in either Brown or Kasila to make the modifications necessary to arrive at Applicants' method.

Regarding paragraph 14 of the Office Action, Applicants are no longer claiming an assay that results in decreased scintillation being correlated with reaction progression. Applicants'

Claim 10 was previously amended to delete phosphatase catalyzed reactions and protease catalyzed reactions. Similarly, Claim 20 is also amended herein to delete these reactions – the reason why Applicants are only now amending Claim 20 is because Claim 20 was supposedly withdrawn from consideration (despite the fact that it is being considered in the Final Rejection) which resulted in a simple oversight.

The comments regarding Claims 3 and 9 in the last section of paragraph 14 are manifestly incorrect since both Claims 3 and 9 are dependent on Claim 1. These dependent claims have all of the limitations of Claim 1 and, therefore, it is impossible for any of these claims to read on an assay where decreased scintillation correlated with reaction progression can be seen.

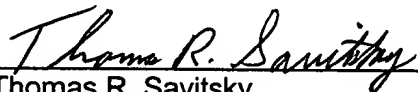
Regarding paragraphs 15 and 16 of the Office Action, as stated above, it is impossible for Applicants claimed method to cover scenarios where decreased scintillation is correlated with reaction progression. Whether or not increased scintillation is explicitly stated in the claims is irrelevant because increased scintillation is the only thing that can occur in Applicants' method. That is, increased scintillation is inherent, it is a consequence of performing Applicants' claimed assay.

Regarding paragraph 17, Applicants reiterate that the obviousness rejection is based on impermissible hindsight reconstruction. The only way one skilled in the art would arrive at Applicants' method, even having Kasila and Brown before him, would be to use Applicants' own disclosure as a guide. There is nothing in either Kasila or Brown that teaches or suggests Applicants' claimed method.

It is respectfully submitted that Applicants' specification and claims are in proper form. Applicants respectfully request that the rejection of Claims 1, 3, 5-10 and 19 be withdrawn and that pending Claims 1, 3 and 5-20 be passed to allowance.

Respectfully submitted,

Novartis  
Corporate Intellectual Property  
One Health Plaza, Building 430  
East Hanover, NJ 07936-1080

  
Thomas R. Savitsky  
Attorney for Applicants  
Reg. No. 31,661  
(862) 778-7909

Date: July 18, 2003